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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,587	02/11/2004	Graham R.F. Napier	TRDB 1006-1	7273

22470 7590 09/15/2006

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,587

Applicant(s)

NAPIER ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2, 8-9, 14, 17, and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,5,8-9,14, 16,22,24,32,37,38,39,45, of copending Application No. 10/228,158. Although the conflicting claims are not identical, they are not patentably distinct from each other because they commonly include limitations such as, " setting authorizations for international shipment participants to enter, view and edit aspects of data that tracks the shipment leading to its delivery"

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Alie et al. (US Publication 2003/0040947 A1), hereinafter Alie..

Regarding claim 1, Alie teaches a computer-aided method of collaborating on the terms and conditions of shipment and sale, the creation of documents and the tracking of an international shipment of goods and approving payment from a credit facility or demand deposit account, the collaboration including an exporter, an importer and an importer's bank, the method including: setting authorizations for international shipment

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participants to enter, view and approve aspects of data that record conditions and instructions for payment from the importer to the exporter (Figs. 1 through 4 and paragraphs 0009-0013, 0024-0034 and 0041-0044 teach that an exporter and an importer enter into an agreement to sell and buy goods at an agreed price and international terms of sale and shipment wherein both the exporter and importer are authorized to enter all the necessary information/data/documents relating to price, description of goods, shipment information, etc. so and transmit the same to the other party, as required, for viewing and verifying leading to payment and delivery of goods), track progress of the international shipment participants toward meeting the conditions for payment, and allow the importer to electronically approve payment to the exporter by the importer's bank from the credit facility or demand deposit account; receiving agreed conditions and instructions for payment; receiving documentation from the exporter or exporter's agent corresponding to fulfillment of the agreed conditions for payment, without need for bank evaluation of the documentation; electronically initiating an approval to pay following evaluation by the importer or the importer's agent that the conditions for payment have been fulfilled, modified or waived, the approval to pay corresponding to the instructions for payment; and receiving a status update confirming payment of the exporter (see Figs 1 through 4 and paragraphs 0009-0013, 0024-0034 and 0041-0044. The tracking system "45" in combination with the information system website "13" and the shipment order system "38" track the progress electronically of both the exporter and the importer towards meeting the conditions of delivery of goods to the importer from the exporter and

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approval of payment from the importer to transmit it to the exporter without the banks having to evaluate the documentation .)

Regarding claims 2-3, Alie discloses that the shipment participants are authorized to view images of documents (see paragraphs 0025-0026 which disclose that all the necessary information/data/documentation relating to order/terms and conditions of sale and shipment are communicated electronically among the shipping participants , that is the exporter, the importer, respective brokerages and banks in order to complete the transaction) and including sending draft conditions and instructions for payment to the exporter ((see Figs 1 through 4 and paragraphs 0009-0013, 0024-0034 and 0041-0044 disclose sellers and purchasers agreeing to predefined terms and conditions, see paragraph 0009) .

Regarding claims 4-5, Alie teaches advising the importer's bank of the agreed conditions and instructions for payment and the payment is executed by the bank, corresponding to the approval to pay (see Figs 1-4, paragraphs 0009-0010 and 0030-0031. Purchaser's bank "27" approves the payment only after receiving that the exporter has shipped the goods and the goods have reached a pre-defined location).

Regarding claims 6, Alie discloses that the method of claim 1, further including exposing to view by the international shipment participants status tracking information regarding establishment of the conditions and instructions for payment, the

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documentation of fulfillment and the approval of fulfillment, or the abatement or waiver of the conditions for payment (see Figs 1 through 4 and paragraphs 0009-0013, 0024-0034 and 0041-0044. The tracking system "45" in combination with the information system website "13" and the shipment order system " 38" track the progress electronically and all the shipping participants that is the exporter, the importer, respective brokerages and banks receive and view the necessary data/information/documentation in order to complete the transaction ..)

Regarding claim 7, Alie discloses that the exposed status information identifies, for particular roles, whether the particular roles are responsible to carry out a next step in the establishment of the conditions and instructions for payment; the documentation of fulfillment; and the approval of fulfillment, or the abatement or waiver of the conditions for payment (see Figs 1 through 4 and paragraphs 0009-0013, 0024-0034 and 0041-0044 disclose that all the shipping participants, that is the exporter, the importer, export brokerage, import brokerage, the banks and the information system web site "13", etc. all have roles to play and are responsible to carry out their individual responsibilities in completing the transaction). .

Regarding claims 8-24, their limitations are closely parallel to the limitations already covered in claims 1-7 and are therefore analyzed and rejected on the basis of same rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

(i) Le et al. US Publication 2003/0069831A) discloses an integrated electronic system and method to execute international trades between a buyer and seller wherein the seller manufactures and/or ships the ordered goods to a predefined destination and in line with predefined price and terms (see at least Abstract and paragraph 0014).

(ii) Riggs et al. (US Patent 6,915,268) discloses an electronic integrated logistic system and method for managing international shipment, having various functionalities, such as evaluating proposals by shippers for shipment of goods, informing contract administration module about the status of shipment proposals and the contracts finalized based on those proposals, maintaining and tracking the shipping schedule and authorizing payments (see at least Abstract and claim 1).

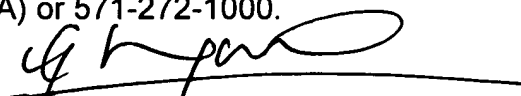
(iii) Lefebvre et al. (US Publication 2002/0091574 A1) discloses an electronic system and method for providing real-time calculation of total landed cost of an international shipment including all costs, freight and tariffs and duties over a computer network (see at least Abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', is written over a horizontal line.

Yogesh C Garg
Primary Examiner
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YCG
9/12/06